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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,616	03/03/2004	Amanda Chinn	1625	2701

7590 10/11/2006  
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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT PAPER NUMBER

3782

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/791,616		CHINN, AMANDA	
	<b>Examiner</b>		<b>Art Unit</b>	
	Justin M. Larson		3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4, 6-8, 11, 13, 14, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the front of the respective pocket's storage section" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

The term "close" in claim 7 is a relative term that renders the claim indefinite. The term "close" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term close implies a relationship between the coefficient of expansion of the film and the bands, however, the range of coefficients that are considered to be "close" is not apparent.

Claims 11 and 16 include the trade name Lycra<sup>®</sup>. If a trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex Parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

In claim 14, it is unclear what structure is intended by the limitation "mesh of fine denier similar to the mesh used in support stockings." Examiner is of the position that support stockings can be made of fabric having varying denier. Therefore, when

comparing the denier of the encircling member to the denier of a support stocking, the denier of the encircling member can vary. Furthermore, the metes and bounds of the term "fine" are unclear.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-10, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorham (US 6,325,260 B1) in view of Coble (US 4,843,653 A).

Regarding claims 1, 2, 4, 5, 6, 8, Gorham discloses a storage device for disposition on a wearer's limb section for the storage of small articles comprising an elastic film (col. 3 lines 18-22), upon which at least one pocket (32) is mounted, said pocket including its own respective front flap (39) having a closure (50, col. 4 lines 7-11) thereon for removable engagement with a closure on the front of the pocket's storage section.

Gorham fails to disclose a limb-encircling member consisting of a pair of spaced apart elastic bands connected to the top and bottom edges of the elastic film. Coble, however, also discloses a device disposed about a user's limb section and teaches that a pair of elastic bands (20) are attached to the upper and lower edges of the device in order to prevent the device from slipping along the user's limb and also to provide additional area to display indicia (col. 1 lines 40-45). It would have been obvious to one

having ordinary skill in the art at the time the invention was made to include a pair of elastic bands on the upper and lower edges of the storage device of Gorham, as taught by Coble, in order to make it less likely that the device would slide along the user's limb and also to provide additional area for displaying indicia.

Regarding claim 7, Examiner is of the position that the elastic bands and the elastic film of the modified Gorham storage device have a close coefficient of expansion as they are both elastic. Examiner notes that Applicant has not clearly defined the relative range that may be associated with the term "close".

Regarding claim 9, Gorham discloses multiple pockets that are separated by a vertical seam (Figure 2).

Regarding claims 10, 12, and 13, the modified Gorham storage device includes the claimed features except for the specific sizes of the pockets. It would have been an obvious matter of design choice to change the size of the pockets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Regarding claim 14, Examiner is of the position that the encircling member of the modified Gorham storage device is thin and thus similar in denier to the mesh of a support stocking.

Regarding claim 15, the claim combines limitations from claims 9 and 14, which have already been shown to be unpatentable over the modified Gorham storage device.

5. Claims 11, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorham in view of Corble, and further in view of Ogean (US 5,924,136 A).

Regarding claims 11 and 17, the modified Gorham storage device includes the claimed features except for the pockets being formed from Lycra<sup>®</sup>. Ogean, however, also disclose a storage device mounted to a user's limb section and teaches that a pocket on the storage device may be formed from Lycra<sup>®</sup> (col. 2 lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the pocket panels of the modified Gorham storage device out of Lycra<sup>®</sup>, as taught by Ogean, since Lycra<sup>®</sup> is a material already known and used in the art for forming pocket panels.

Regarding claim 16, the modified Gorham storage device includes the claimed features except for the specific sizes of the pockets. It would have been an obvious matter of design choice to change the size of the pockets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorham in view of Coble, and further in view of Teed (US 6,105,837 A).

The modified Gorham storage device as applied to claim 1 above includes the claimed features except for the encircling member being an elastic band disposed interiorly of the elastic film. Teed, however, also discloses a storage device worn about

a user's limb section and teaches that an elastic band (20) may be located interiorly of band portion (12) in order to give the band elastic properties for gripping a user's limb. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the elastic bands of the modified Gorham storage device with an interiorly mounted elastic band, as taught by Teed, since the elastic bands taught by both Coble and Teed are art equivalent means for providing a limb-mounted band with elastic properties. To choose between these two would be an obvious matter of design choice.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 19 above in view of Warren (US 1,382,446 A).

The modified Gorham storage device as applied to claim 19 above includes the claimed features except the pocket flaps being V-shaped. Warren, however, also discloses a storage device to be worn about a user's limb section and teaches that the pocket flap is V-shaped. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the pocket flaps of the modified Gorham storage device in a V-shape, as taught by Warren, since such a shape is already known for pocket flaps.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML  
9/21/06

  
NATHAN J. NEWHOUSE  
SUPERVISORY PATENT EXAMINER